

REMARKS**I. General**

Claims 1-20 are pending in the current application and claims 1-20 are rejected. The issues raised in the Office Action mailed April 21, 2004 are:

- Claims 1, 4-5, 7-8, 10, 12-13, 15-17, and 20 are rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and distinctly claim the subject matter which applicant regards as the invention;
- Claims 1-20 are rejected under 35 U.S.C. § 101 as non-statutory because the method claims as presented do not claim a technological basis in the claim;
- Claims 1-13 and 16-20 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,401,080 to Bigus et al. (hereinafter *Bigus*) in view of U.S. Patent No. 6,605,121 to Roderick (hereinafter *Roderick*);
- Claim 14 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Bigus* in view of *Roderick* as applied to claim 1 and further in view of U.S. Patent No. 5,905,975 to Ausubel (hereinafter *Ausubel*); and
- Claim 15 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Bigus* in view of *Roderick* as applied to claim 1 and further in view of U.S. Patent No. 6,260,024 to Shkedy (hereinafter *Shkedy*).

II. Claim Amendments

Claim 20 is cancelled. Claims 1-18 are amended and new claims 21-36 are entered. Claims 1-17 are amended to clarify that the method presented is a method for electronically negotiating a commercial transaction, as supported in the specification at (page 1, lines 5-12 and page 3, lines 1-15). Claim 18 is amended to clarify some claim language. New claims 21-36 present a computer program product claim set. Support for new claims 21-36 is found throughout the specification which makes several indications that the disclosed negotiation protocol is for use in electronic negotiations, such as negotiations conducted over the Internet. (Specification, page 3, lns. 1-15). No new matter is introduced by the claim amendments and additions presented herein.

III. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1, 4-5, 7-8, 10, 12-13, 15-17, and 20 are rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants do not agree or concede that the rejected terms are vague and indefinite. However, in an effort to speed prosecution of this application, the claims are amended to address the § 112 rejections. These amendments are not intended to be narrowing, but are instead intended to use alternate language that has the same scope as the original term. Applicants respectfully ask the Examiner to withdraw the § 112 rejections in light of the amendments.

IV. Rejection under 35 U.S.C. § 101

The Examiner rejected claims 1-20 under 35 U.S.C. § 101 as non-statutory because the method claims as presented do not claim a technological basis in the claim. (Office Action, page 5). Applicants respectfully traverse this rejection and assert that the rejection of claims 1-20 under 35 U.S.C. § 101 is improper.

Applicants respectfully assert that in order to properly reject a claim under 35 U.S.C. § 101, an Examiner must (A) make a prima facie showing that the claimed invention lacks utility and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the prima facie showing. M.P.E.P. § 2107.02 (IV) citing *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975). However, a mere statement by the Examiner that the pending claims are non-statutory because they do not claim a technological basis fails to establish a prima facie showing that the claims lack utility under 35 U.S.C. § 101.

The Office Action asserts that the method claims as presented do not claim a technological basis in the claim and therefore the claims are non-statutory under 35 U.S.C. § 101. (Office Action, page 5). The Office Action does not cite any authority that supports such assertion by the Examiner. As discussed below, Applicants submit that claims 1-20 satisfy the requirements of the language of 35 U.S.C. § 101, and Applicants are not aware of any additional criteria beyond that addressed below which Applicants' claims are required to satisfy in order to be considered proper patentable subject matter under 35 U.S.C. § 101. Thus, Applicants respectfully request that the Examiner specifically identify the law, rule or other authority on which the Examiner relies in making the above statement.

35 U.S.C. § 101 provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful

improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title” (emphasis added). M.P.E.P. § 2106.IV.A. explains:

As cast, 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” while the first category defines “actions” See 35 U.S.C. 100(b) (“The term ‘process’ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”).

Thus, a process is recognized specifically by 35 U.S.C. § 101 as appropriate subject matter of a patent. As such, Applicants respectfully submit that the claims of the present application that are directed to a “method” fall within this recognized category of appropriate patentable subject matter. Accordingly, 35 U.S.C. § 101 provides that Applicants “may obtain a patent therefor, subject to the conditions and requirements” of title 35 of the U.S.C.

As the Supreme Court has held, Congress chose the expansive language of 35. U.S.C. 101 so as to include “ anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 U.S.P.Q. 193, 197 (1980). M.P.E.P. § 2106.IV.A. further explains that the “subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena” (emphasis added). “These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomena is not patentable.” M.P.E.P. § 2106.IV.A. (emphasis in original).

The rejection asserted by the Examiner under 35 U.S.C. § 101 in asserting that “the claim may be interpreted as involving no more than a manipulation of an abstract idea” is effectively alleging that claims 1-20 of the present application falls within one of the above three exclusions (e.g., abstract ideas). However, Applicants submit that claims 1-20 provided in the present application do not fall within the above three exclusions because they recite subject matter that is a “practical application or use” for the method.

For example, claim 1, as amended, recites, “a method for conducting an electronic negotiation of a commercial transaction.” As described in the specification of the present application, conducting an electronic negotiation has much application, and as examples, using such negotiation may allow negotiating parties to negotiate multiple attributes

simultaneously and thereby allow for multi-attribute compromise. (Specification, page 2, lns. 15-20). In addition, negotiation parties may keep knowledge of their least favorable acceptable conditions confidential, as third parties are unnecessary. (Specification, page 2, lns. 20-25). Thus, the pending claims clearly recite subject matter that is a practical application or use of the method.

Furthermore, Applicants respectfully submit that there is no requirement that the practical application(s) or use(s) be expressly recited in the method claims. Rather, it is sufficient that at least one such practical application or use can be determined from the application's specification, which evidences that the claimed method has some utility. In the present case, many example practical applications for the claimed method have been described in the specification (as noted above), thus evidencing that the claimed method does not lack utility but instead has utility at least in the example practical applications identified in the specification.

The present Office Action appears to concede that the pending claims would have utility if the claims would include some interrelationships that are solely by computer. (Office Action, page 5). However, there is no requirement that methods be claimed with an interrelationship to a computer in order for the method to have utility. Moreover, as long as there is at least one immediate beneficial use for the method, it satisfies the utility requirement. As M.P.E.P. § 2107.02 (I) provides "regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112". *Citing In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964). Thus, if applicant makes one credible assertion of utility, utility for the claimed invention as a whole is established. M.P.E.P. § 2107.02 (I).

Moreover, claims 1 and 17 are amended to clarify the claim language so that claims 1-19 clearly claim a method for electronically negotiating a commercial transaction that involves a series of steps which are clearly statutory subject matter. Therefore, Applicants respectfully request that the rejection of claims 1-19 under 35 U.S.C. § 101 be withdrawn. In view of the above, Applicants respectfully submit that claims 1-19 are directed to proper statutory subject matter in accordance with 35 U.S.C. § 101, and thus withdrawal of this rejection is requested.

V. Rejection under 35 U.S.C. § 103 (a) –*Bigus & Roderick*

The Examiner rejected claims 1-13 and 16-20 under 35 U.S.C. § 103 (a) as being unpatentable over *Bigus* in view of *Roderick*. The rejections of claim 20 is moot as claim 20 is cancelled. However, Applicants respectfully traverse the rejection of claims 1-13 and 16-19 and assert that the rejected claims are allowable at least for the reasons stated below. In addition, Applicants respectfully assert that new claim 21 is also patentable over the combination of *Bigus* in view of *Roderick* for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art cited must teach or suggest all the claim limitations. M.P.E.P. § 2143. Applicants respectfully assert that the prior art does not teach or suggest all the claim limitations, and, therefore, the claims are patentable under 35 U.S.C. § 103(a).

Failure to teach or suggest all claim limitations**A. Independent Claims****Claim 1**

Claim 1, as amended, recites, in part:

a step of looking-up, wherein the product listed in the advertisement is located for a second negotiating party, wherein at least one of a first set of attribute-value pairs is displayed to the negotiating party;

Claim 17

Claim 17, as amended, recites, in part:

looking-up the product from the advertising step, wherein the looking-up step comprises:

displaying to a second negotiating party the set of attribute-value pairs; and

comparing one or more attribute-values provided by the second negotiating party with the set of attribute-value pairs in the advertisement to find a match;

Claim 21

Claim 21 recites, in part:

code for looking-up said product listed in said advertisement for a second negotiating party, wherein at least one of a first set of attribute-value pairs is displayed to said second negotiating party;

The disclosure of *Bigus* in view of *Roderick* fails to disclose these features of claims 1, 17, and 21. *Bigus* discloses an intelligent agent and method for negotiating therewith that utilizes features to enhance the productivity, security, efficiency, and responsiveness of the agent in negotiations with other parties. (*Bigus*, col. 3, lns. 50-65). In addition, *Bigus* discloses that the agents generate offers, wait for responses from negotiating parties, and then determine whether to complete the transaction based upon the responses. (*Bigus*, col. 4, lns. 1-6). However, *Bigus* fails to disclose or suggest a method of looking-up the product from the advertising step and fails to disclose code for looking-up said product listed in said advertisement for a second negotiating party, as recited above in claims 1, 17, and 21.

Roderick fails to cure this deficiency of *Bigus*. *Roderick* discloses a method and system for managing and delivering information over a data network whereby instructions are generated to create an information page if the information page does not exist. (*Roderick*, col. 2, lns. 35-50). However, there is no teaching or suggestion of a method of looking-up or code for looking-up as required by claims 1, 17, and 21. Thus, the disclosures of *Roderick* and *Bigus*, either alone or in combination, fail to disclose and/or suggest all the elements of claims 1, 17, and 21. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) for claims 1 and 17 be withdrawn and respectfully assert that new claim 21 is patentable over the combination of *Bigus* in view of *Roderick*.

Furthermore, the Examiner admits that the disclosures of *Bigus* in view of *Roderick* fail to disclose these features. (Office Action, pages 7-8). Yet, in an effort to overcome these deficiencies of *Bigus* in view of *Roderick*, the Examiner asserts that these features are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited, and therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. (Office Action, page 8). Applicants respectfully traverse this assertion and submit that these features are functionally involved in the claims, and as such, these features must be afforded patentable weight in distinguishing the claimed invention from the prior art. Applicants respectfully assert that the M.P.E.P. requires that when evaluating the scope of a claim, every limitation in the claim must be considered, and Examiners may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. M.P.E.P. § 2106 II (C). Thus, the features relating to the step of looking-up and code for looking-up must be given patentable weight and must be considered

by the Examiner when distinguishing the claimed invention from the prior art. Therefore, Applicants respectfully request that the Examiner afford patentable weight to all features of claims 1-19 and 21-36 when examining the pending claims in light of the prior art.

Moreover, Applicants respectfully assert that these features are functional steps and not merely descriptive material. For example, the step of looking-up the advertised product is positively recited as a step performed in the claimed method. As such, these features of looking-up and code for looking up are not merely descriptive material and must be afforded patentable weight. Applicants respectfully remind the Examiner of M.P.E.P. § 2173.05(g) which states: “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.”

B. Dependent Claims

Claims 2-16, 18, 19, and 22-36 depend directly or indirectly from their respective base claims 1, 17, and 21 and thereby inherit all of the limitations of their respective base claims. Accordingly, it is respectfully submitted that the dependent claims are allowable based on at least their dependency from independent base claims 1, 17, and 21 for at least the reasons discussed above. Thus, Applicants respectfully submit that based on the arguments above, claims 2-16, 18, 19, and 22-36 are patentable under 35 U.S.C. § 103.

VI. Rejection under 35 U.S.C. § 103 (a) –*Bigus, Roderick, & Ausubel*

The Examiner rejected claim 14 under 35 U.S.C. § 103 (a) as being unpatentable over *Bigus* in view of *Roderick* and further in view of *Ausubel*. Applicants respectfully traverse this rejection of claim 14 and respectfully submit that the features of claim 14 and similar features present in new claim 34 are allowable at least for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art cited must teach or suggest all the claim limitations. MPEP § 2143. Applicants respectfully assert that the cited references of *Bigus*, *Roderick*, and *Ausubel* do not teach or suggest all the claim limitations of claim 14 and new claim 34, and therefore, claim 14 and new claim 34 are not obvious under 35 U.S.C. § 103(a).

Claim 14 and new claim 34 depend from their respective base claims 1 and 21, and thus inherit all the limitations of the respective base claims. As pointed out above, the combination of *Bigus* in view of *Roderick* fails to teach all the limitations of claims 1 and 21, and the teachings of *Ausubel* are not relied upon as teaching these limitations. Thus, the combination of *Bigus*, *Roderick*, and *Ausubel* fails to teach all the claim limitations of claim 14 and new claim 34. Thus, Applicants respectfully assert that claim 14 and new claim 34 are patentable under 35 U.S.C. §103.

VII. Rejection under 35 U.S.C. § 103 (a) –*Bigus*, *Roderick*, & *Shkedy*

The Examiner rejected claim 15 under 35 U.S.C. § 103 (a) as being unpatentable over *Bigus* in view of *Roderick* and further in view of *Shkedy*. Applicants respectfully traverse this rejection of claim 15 and respectfully submit that the features of claim 15 and similar features present in new claim 35 are allowable at least for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art cited must teach or suggest all the claim limitations. MPEP § 2143. Applicants respectfully assert that the cited references of *Bigus*, *Roderick*, and *Shkedy* do not teach or suggest all the claim limitations of claim 15 and new claim 35, and therefore, claim 15 and new claim 35 are not obvious under 35 U.S.C. § 103(a).

Claim 15 and new claim 35 depend from their respective base claims 1 and 21, and thus inherit all the limitations of the respective base claims. As pointed out above, the combination of *Bigus* in view of *Roderick* fails to teach all the limitations of claims 1 and 21, and the teachings of *Shkedy* are not relied upon as teaching these limitations. Thus, the combination of *Bigus*, *Roderick*, and *Shkedy* fails to teach all the claim limitations of claim 15 and new claim 35. Thus, Applicants respectfully assert that claim 15 and new claim 35 are patentable under 35 U.S.C. §103.

VIII. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants acknowledge that a fee is due with this response due to the addition of claims 21-36. Accordingly, Applicants include such fee with this response. However, if any other fee is due, please charge Deposit Account No. 08-2025, under Order No. 10992554-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail Label EV482736002US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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